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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,649	04/11/2001	Debbie Indira Lewis	RCA 88650	7334

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EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
2613	

DATE MAILED: 04/08/2004

[Handwritten mark]

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/743,649

Applicant(s)

LEWIS ET AL.

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 1 is objected to because of the following informalities:

- "...**maximum** number of plurality of bookmarks which **may be** associated with the storage medium". Examiner interprets maximum broadly due to the use of "may be" associated with the storage medium and lack of description in specification as well as drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 11 are rejected under 35 U.S.C. 102(b) as being unpatentable by Custers et al (US 5,063,547).

[claims 1 & 11]

In regard to Claims 1 and 11, Custers et al discloses a method and apparatus of controlling a system for processing stored information on a storage medium, comprising the steps of:

- (a) Playing back stored information during a play mode of operation (Figure 1 element 3 stores information during playback mode);

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(b) Providing to a user, during play mode of operation, an opportunity to select a bookmark, representing a corresponding location within the stored information, from among a plurality of bookmarks responsive to user input (Column 1 Lines 24+ “...selection means responsive to the detected record-carrier identification to select or to select a preferred-selection program stored in the storage means,”;

(C) Changing to playing back the stored information from the location corresponding to the selected bookmark during the play mode of operation, characterized in that step includes:

- o Determining the number and maximum number of bookmarks, which may be associated with the storage medium (Figure 3 shows blocks of memory where a code is assigned to each block thereby the code becomes a bookmark to the data. Only a certain number of blocks can be held depending on the storage medium size. Thereby it can be said the number of bookmarks can be determined due to the number of blocks of data are present as well as the maximum number of bookmarks by comparing the number of blocks that are able to fit in the storage medium as described in Column 4 Lines 31+);
- o Generating an on-screen menu displaying the maximum number of the plurality of bookmarks available and the actually available ones of the plurality of bookmarks associated with the storage

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medium (Column 4 Lines 40+ describes showing the sequence number/bookmarks to the user. Figure 1 element 13);

- o The menu allowing the user to perform one of the following:
setting a new bookmark, selecting a bookmark and clearing the selected bookmark, selecting a bookmark and play back the stored information from the location corresponding to the selected bookmark; and undo a previously performed operation while continuing to watch the program information playback in a background portion of the video display (Column 5 Lines 1-20 describes the action of erasing a bookmark or re-selecting a bookmark from the disc and thereby selecting a new bookmark).

[claim 2]

In regard to Claim 2, Custers et al discloses a method comprising the steps of:

- Grouping the plurality of bookmarks into sets each having a predetermined number of bookmarks (Figure 2 shows the index table comprising serial data in the form of groups of data used to group bookmarks together);
- Storing each group of bookmarks (Column 4 Lines 9-11);
- Providing to the user an opportunity to retrieve a desired set of bookmarks (Column 4 Lines 45-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers et al (US 5,063,547) in view of Swenson et al (US 6,064,380).

[claim 3]

In regard to Claim 3, Custers et al discloses a system that changes the playback of stored information corresponding to location of data of a bookmark (Figure 1 element 3 processes the playback information while element 6 changes the stored information corresponding to the location of the selected bookmark); however, lacks to provide a user an opportunity to select a first and second bookmark from among the plurality of bookmarks. Swenson et al discloses a bookmark for multi-media content wherein various bookmarks can be selected and deselected as seen in Figure 3 mode 304 and described in Column 4 lines 20+. Allowing the user to change the option of bookmarks and save the options (seen in Figure 5) allows for the user to change and set options to the users' liking.

Therefore, it would be obvious to one skilled in the art at the time of the invention to use Custers et al system of storage of bookmarks and incorporate Swenson et al system of allowing the user to choose and select between various bookmarks within the system. By incorporating the two methods it would allow the user full access to the book marking system.

[claims 4 and 10]

In regard to Claims 4 and 10, Custers et al discloses a method wherein the step of selectively continually repeating the playback of the stored information from the location

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corresponding to the first selected bookmark to the location corresponding to the location of the another bookmark, in response to user control (Column 3 Lines 7-20 describe the storing of selections as well as changing the selection when user selects another bookmark to be used).

[claim 6]

In regard to Claim 6, Custers et al discloses a method of determining whether a bookmark is selected; however, lacks a mode of operation enabling user access to bookmarks during play mode of operation is enabled. Swenson et al discloses a system of playback mode (Figure 3 element 304) depending on the mode will either enable or disable access to the user as seen in Figure 4. By incorporating modes that enable or disable access to the user allows for the system to process information correctly when in recording or playback modes.

Therefore, it would be obvious to one skilled in the art at the time of the invention to use Custers et al system of storage of bookmarks and incorporate Swenson et al system of enabling and disabling modes to the users in order to allow for proper execution of the bookmark depending on the present mode of operation.

Claims 5, 7, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Custers et al (US 5,063,547).

[claims 5 & 7]

In regard to Claim 5, Custers et al discloses a method wherein the storage medium is a CD disk, and wherein the step of determining the bookmarks actually present for the particular CD disk comprises evaluating data related to the CD disk in non-volatile memory in the disk player (Column 2 Lines 12+).

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Examiner takes official notice that it is obvious to one skilled in the art at the time of the invention to incorporate a DVD system, over Custers et al system comprising a CD player, in order to allow the user easier accessibility as well as a larger storage medium.

[claims 8 & 9]

In regard to Claims 8 and 9, Custers et al discloses a method of setting a new bookmark in response to a user command (Column 3 Lines 7+); however, lacks comprises storing data associated with a pause and resume function, including the nearest NAV_PACK address, in conformance with the DVD specification.

Examiner takes official notice that a pause and resume function would use NAV_PACK according to the DVD specification and it would be obvious to one skilled in the art at the time of the invention that a flag would be used for pointing to an address as seen in Claims 8 and 9 as the NAV_PACK.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- *Adolph et al (US 6,370,323);*
- *O'Connor et al (US 6,591,058); and*
- *Budow et al (US 5,625,864)*

Contact Fax Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

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703.208.6306 (for formal communication intended for entry)
703.308.5359 (for informal or draft communications, please label "PROPOSED"
or "DRAFT")

*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).*


Contact Information

*Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-0378.*

*If any attempts to reach the examiner by telephone are unsuccessful, the examiners
supervisor, Christopher Kelley, can be reached at (703) 305-4856.*

*Any inquiry of a general nature or relating to the status of this application should be
directed to the Group receptionist whose telephone number is (703) 305-4700.*

JN
Miss Jamie Vent
04/05/2004


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